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IN THE

SUPREME COURT OF THE UNITED STATES

October Term, 1957

No. 640

BRIGGS & STRATTON CORPORATION,

Plaintiff-Petitioner,

v.

CLINTON MACHINE CO., INC.,

Defendant-Respondent.

PETITION FOR CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE EIGHTH CIRCUIT

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Petitioner, Briggs & Stratton Corporation, plaintiff and appellant in the courts below, prays that a writ of certiorari issue to review the judgment herein of the United States Court of Appeals for the Eighth Circuit, insofar as the same relates to the patent to Lechtenberg No. 2,693,789.

Said judgment was entered October 9, 1957. The opinion of the Court of Appeals was released August 30, 1957 and rehearing was denied on October 3, 1957.

OPINIONS BELOW

The opinion of the United States District Court for the Northern District of Iowa, Eastern Division is reported at 147 F. Supp. 361, 112 U.S.P.Q. 93. The opinion of the Court of Appeals for the Eighth Circuit is reported at 247 F. (2d) 397, 114 U.S.P.Q. 438.

JURISDICTION

The judgment of the Court of Appeals sought to be reviewed was dated and entered October 9, 1957. A petition for rehearing was duly filed on September 18, 1957 and was denied without opinion on October 3, 1957.

This Court has jurisdiction under 28 U.S.C., Secs. 1254 (1) and 2101 (c).

QUESTIONS PRESENTED

1. Is it a patentable improvement, under 35 U.S.C. § 101, to rearrange the structure of an old and well known device, where the new arrangement brings about a phenomenal reduction in the cost of producing the device, without any reduction in its quality, but produces no new function in the device and results in no change in its operation?

2. Is a patent claim valid if it relates to a known device, comprising old structural elements performing their conventional functions, *but* defines a *new arrangement* of those old structural elements, by reason of which new arrangement the device is producible by a highly advantageous production process, long known and appre-

ciated but the use of which had never before been attainable for production of that device?

3. Where, in a highly developed, fiercely competitive industry, producing a device in a crowded art, a structural change which is recognized as novel brings about a 24% reduction in cost of the device and a 50% reduction in its weight (both cost and weight being recognized as crucial competitive factors), and provides other significant advantages without any offsetting disadvantages, is this sufficient evidence of unobviousness of the improvement to meet the test of patentability laid down in 35 U.S.C. § 103?

STATUTES INVOLVED

The following two sections of the Patent Codification Act (Title 35 U.S.C.) are here involved:

> § 101. *Inventions patentable.* Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.
>
> § 103. *Conditions for patentability; non-obvious subject matter.* A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

STATEMENT OF THE CASE

This is an action for infringement of three patents, two of which are no longer in issue.

The patent here involved, No. 2,693,789 (RP-509), issued to Leo Lechtenberg on November 9, 1954, and was assigned to plaintiff-petitioner, Briggs & Stratton Corporation. Claims 1, 2, 4, 5, 6, 7, 8, 14, 15 and 16 are charged to be infringed by defendant's model VS-100 engine. (R 450)

After a full trial on the merits the District Court held the claims in suit valid and infringed. (R 190-206) Defendant thereafter moved for a supplemental trial on the grounds of alleged newly discovered evidence. (R 473-474) Although most of the so-called newly discovered evidence had been before the court at the original trial, the District Court, out of an abundance of caution, reopened the case to permit both parties to present any additional evidence they wished to introduce. (R 207) After the additional trial proceedings, the District Court reversed its original decision and held the Lechtenberg patent invalid (R 438-464) adding, however, that the accused engine is "a striking and almost slavish copy" of the engine shown in the patent and that: "If the claims of the Lechtenberg patent * * * do define inventive combination, the defendant's accused engine clearly infringes." (R 460-461)

The Court of Appeals affirmed the decision of the District Court as to invalidity and held that: " * * * upon the adjudication that the patent is invalid the question of infringement becomes moot." (Appendix to this petition, pp. 7-8)

The Lechtenberg patent relates to single cylinder four-cycle engines, and covers a new arrangement of the body

elements of such an engine, which arrangement enables production of the engine body at much lower cost than had ever before been possible. (R 52, 56; RP-527, col. 1, line 81-col. 2, line 8)

Prior to the Lechtenberg invention the main body parts of single cylinder four-cycle engines had always been made as sand castings, usually of gray iron. (R 24, 57-58, 60, 67, 125, 245, 250-252, 255-256, 258, 369, 371-372) Sand casting is a slow, cumbersome and expensive production method, entailing tremendous amounts of hand labor necessarily performed under unpleasant conditions. (R 370) Iron is the best material for sand castings; aluminum can be sand cast, but a good aluminum sand casting is difficult to make. (R 416, 430)

Since 1914 there has been available a production method known as die casting which is largely automatic and therefore fast, inexpensive and accurate. Die casting works well with aluminum, and aluminum has long been recognized as a desirable material for engine bodies. (R 416, 417)

The single cylinder four-cycle engine industry is well over 40 years old. Its art is crowded and highly developed; decades of fierce competition have spurred a quest for every possible improvement. Nevertheless, as late as 1950 the main body parts of single cylinder four-cycle engines were still being made by the archaic and expensive sand casting process, although the industry had grown up with die casting and was thoroughly familiar with its techniques and advantages. (R 370-371)

This adherence to sand casting of the main body parts was especially significant because it was a foregone conclusion that anyone who could die cast the main body parts of a four-cycle engine would enjoy a spectacular

commercial success. Not only would die casting afford a tremendous price advantage, but the lighter engine that would result from the use of aluminum would open to the four-cycle engine vast new markets previously closed to it because of the weight and cost of its sand cast gray iron body. (R 54, 253, 255, 263, 266, 321-322, 419-420)

It is necessary to know something about the problems involved in designing a single cylinder four-cycle engine body in order to understand why the industry was unable to go to die casting of main body parts prior to Lechtenberg, and why the four-cycle engines now made with die cast body parts are close copies of the Lechtenberg arrangement; and an understanding of these facts is also necessary in order to appreciate the important unresolved questions of law raised by the decisions of the courts below.

A four-cycle engine body is essentially an irregularly shaped, completely closed box or chamber. One portion of the enclosure is the cylinder in which the piston reciprocates, and another portion is the crankcase, which houses the rotating crankshaft and cam shaft and the timing gears connecting them, and also provides an oil reservoir or "sump". Hence, the engine body can be visualized, in terms of function, as one integral piece, with seamless body walls that are continuous all the way around. Ideally, from the standpoint of function alone, that would be the best way to build it.

But an engine can not be built with a one-piece body, any more than a block of wood can be hollowed out without cutting through it or boring into it. Therefore an engine body has to be built in two or more parts which are assembled to form the body enclosure.

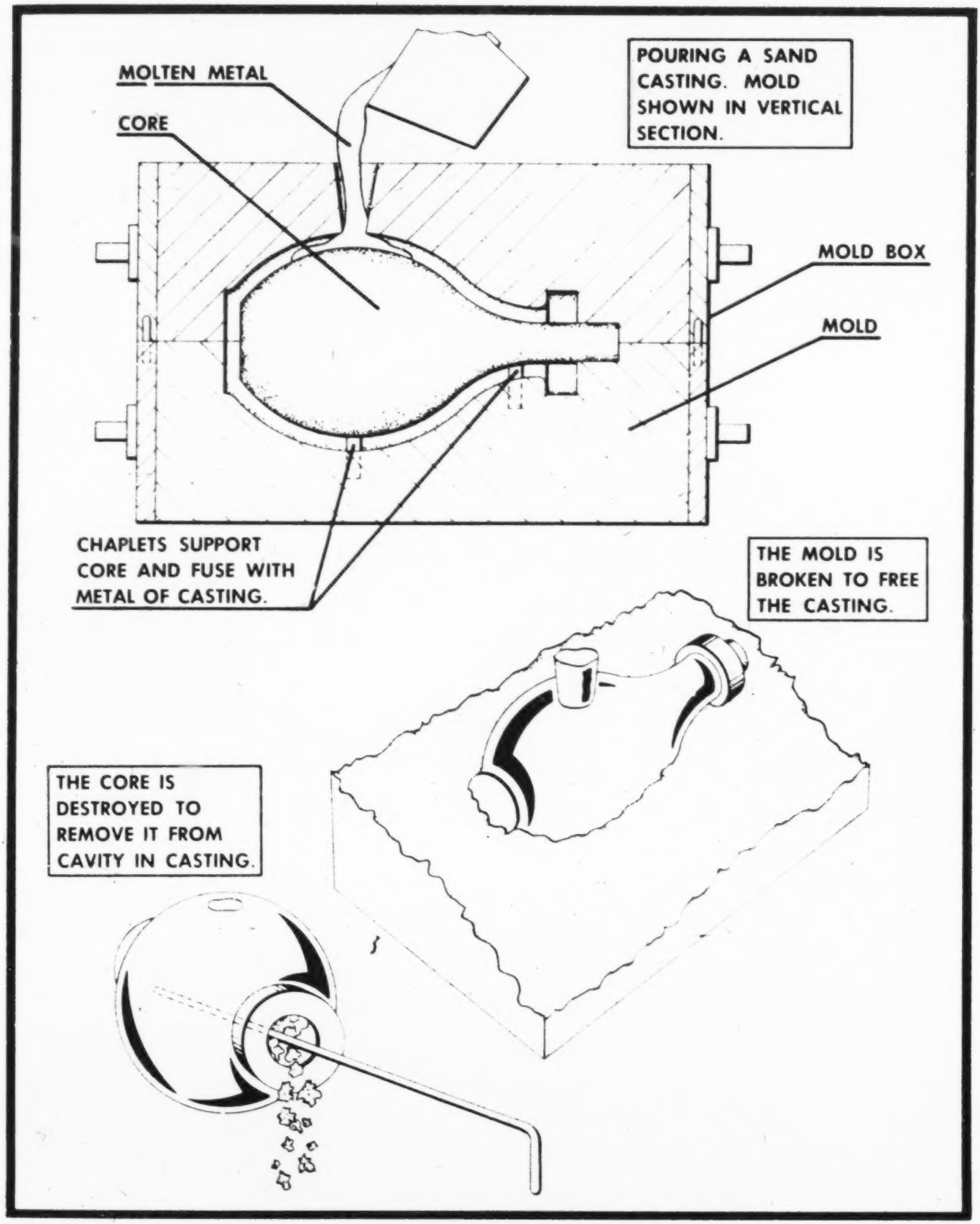
MOLTEN METAL
CORE
POURING A SAND CASTING. MOLD SHOWN IN VERTICAL SECTION.
MOLD BOX
MOLD
CHAPLETS SUPPORT CORE AND FUSE WITH METAL OF CASTING.
THE MOLD IS BROKEN TO FREE THE CASTING.
THE CORE IS DESTROYED TO REMOVE IT FROM CAVITY IN CASTING.

FIGURE 1

IN SAND CASTING, THE MOLD AND CORES ARE DESTROYED TO FREE THE CASTING, HENCE THERE ARE NO LIMITATIONS UPON THE FORM OF A PART TO BE SAND CAST.

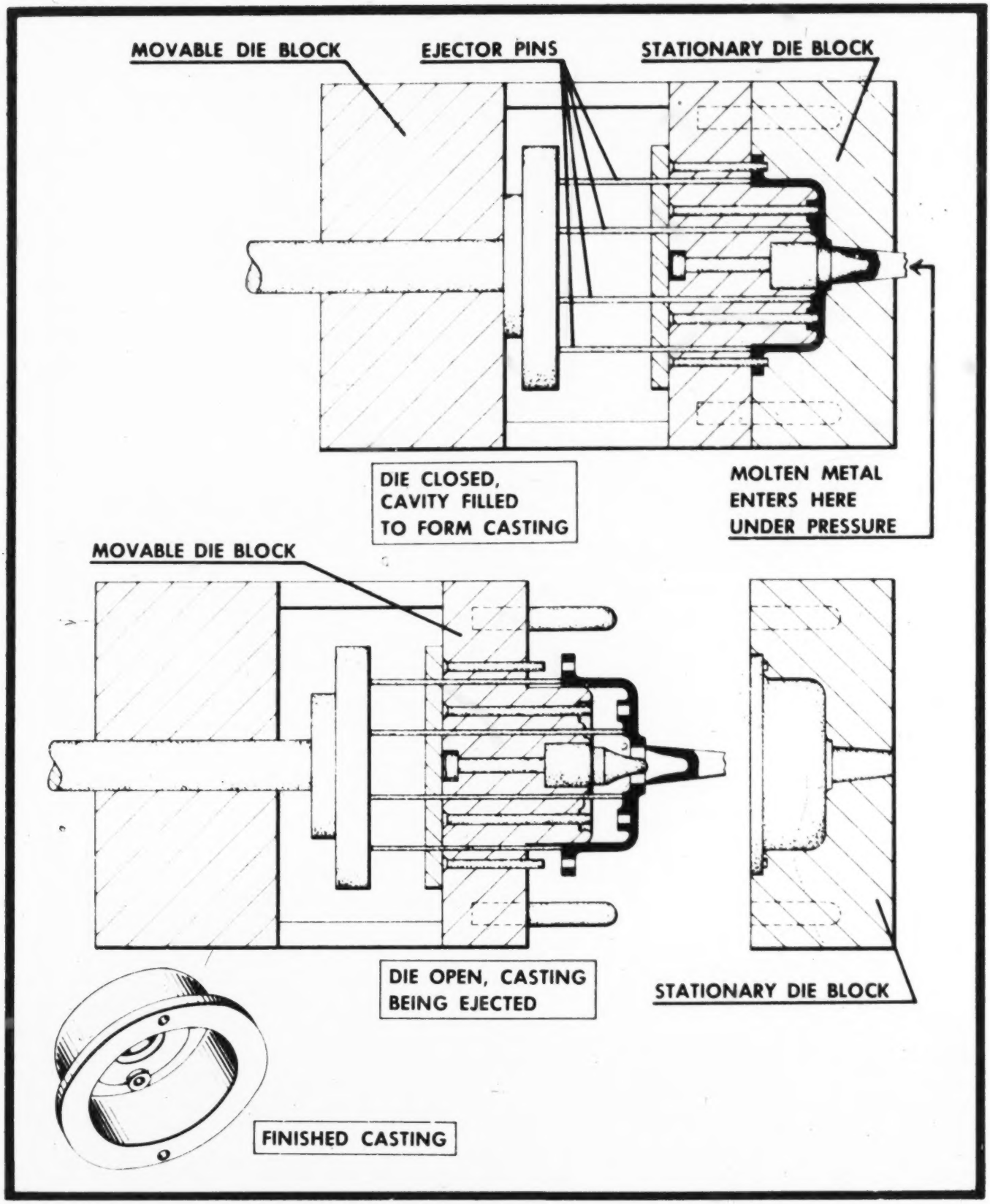

FIGURE 2

IN DIE CASTING, THE DIE AND CORES ARE RE-USED INDEFINITELY, AND THE CASTING MUST THEREFORE HAVE A FORM SUCH THAT THERE WILL BE NO DAMAGE TO DIE OR CASTING WHEN THE CASTING IS RELEASED FROM THE DIE MEMBERS. (ADAPTED FROM FIGS. 18 and 19, P. 28, 29 DESIGNING FOR ALCOA DIE CASTINGS; ALUMINUM CO. OF AMERICA, 1949).

Making the body in two or more parts has nothing to do with the way the engine operates or what it does — it is simply a production expedient.

In designing a four-cycle engine body that can be *made*, the designer has always visualized the engine body as the one-piece unit which would be the theoretical ideal, and he has made (in theory) certain slices or cuts through that hypothetical one-piece body, separating it into a number of parts. Those parts were what he actually produced and assembled.

Prior to Lechtenberg the hypothetical one-piece four-cycle engine body had been "sliced" in several different ways, but every prior art engine body had always been divided into *three* or more parts, plus a cylinder head. (R 61, 294, 418) Almost invariably, one of those parts was a large main cylinder-crankcase member that was complex and expensive to cast, and the other parts were smaller and less expensive castings that were fastened to the main casting to form the engine body.

Four-cycle single cylinder engines are used in a wide variety of applications and installations, each of which always necessitates some differences in the engine body. (R 50-51, 213) Prior to Lechtenberg most of these differences between the body castings of one engine model and another in a full "line" of engines of one size appeared on the main cylinder-crankcase body casting. (R 337-338, 55-56) *Always* for more than a generation, when the prior art four-cycle engine designer had made his theoretical slices through the engine body, he found that his big, main cylinder-crankcase member was not adaptable to all of the different engine models in his company's line. As a result, many *different* patterns or molds were needed to produce that one big part for a full "line" of

engines of one size, in order to take care of all of the different customer needs.

When engines were being sand cast, the large number of different main body casting patterns[1] needed to produce a full "line" of engines was a nuisance, and, while it was expensive to have so many different patterns, it was not prohibitively so. (R 55-56)

But a die casting die for a main cylinder-crankcase member costs in the neighborhood of $30,000.00. (R 31, 38) If there had to be dozens of different dies for the cylinder-crankcase members of a full "line" of engines, as was always the case with engine bodies having the prior art "slices", the investment in dies would have been prohibitive, and therefore a die cast engine was economically impossible, because it could not have been sold at a competitive price. Lechtenberg opened the door to the die casting of four-cycle engine body parts by making it economically feasible to die cast those parts.

In effect, Lechtenberg said to the art: "All these years you have been making your slices through the hypothetical one-piece engine body in the wrong place. All that you need to do is to make just one slice, dividing the engine body into only two parts. *If you make that slice in the right place* you will have a big, main cylinder-crankcase casting that will be universally adaptable, and it will also be die castable on ordinary die casting ma-

---

[1]In sand casting, sand mixed with a binder is packed around a pattern having the shape of the part to be cast, and the pattern is then removed from the sand to leave a correspondingly shaped cavity or mold. Molten metal is poured into the sand mold, and when the metal has cooled the mold is broken to free the casting

chines;[1] and you will have a small cover, complementing the big part, which can be inexpensively produced in a variety of forms to accommodate all of your many different customer requirements."

Thus, Lechtenberg's new "slice" permits an engine manufacturer with only one cylinder-crankcase mold to turn out a full line of four-cycle engines of one size, embodying *every* modification and adaptation that customers could conceivably want. The changes or variations from one engine modification to another are *all* incorporated in a simple cover casting that complements the main cylinder-crankcase part. (R P-528, col. 4, lines 26-39; P-532, col. 11, lines 29-63)

Nobody in the industry had ever before thought of putting the "slice" in the place where Lechtenberg said it should be. The decisions of the courts below not only avoid any statement that the claims of the Lechtenberg patent read on any prior art engine body, but expressly concede that there is novelty in Lechtenberg's arrangement. (R 460 (Finding 18); Appendix to this petition, P. 8)

In any event, the novelty of Lechtenberg's arrangement is apparent from the fact that there had never been a die cast four-cycle engine body prior to Lechtenberg, despite the tremendous incentive to go to die casting if it could be done, and the die cast four-cycle bodies produced since Lechtenberg's invention are close copies of his invention. As soon as defendant saw the new way

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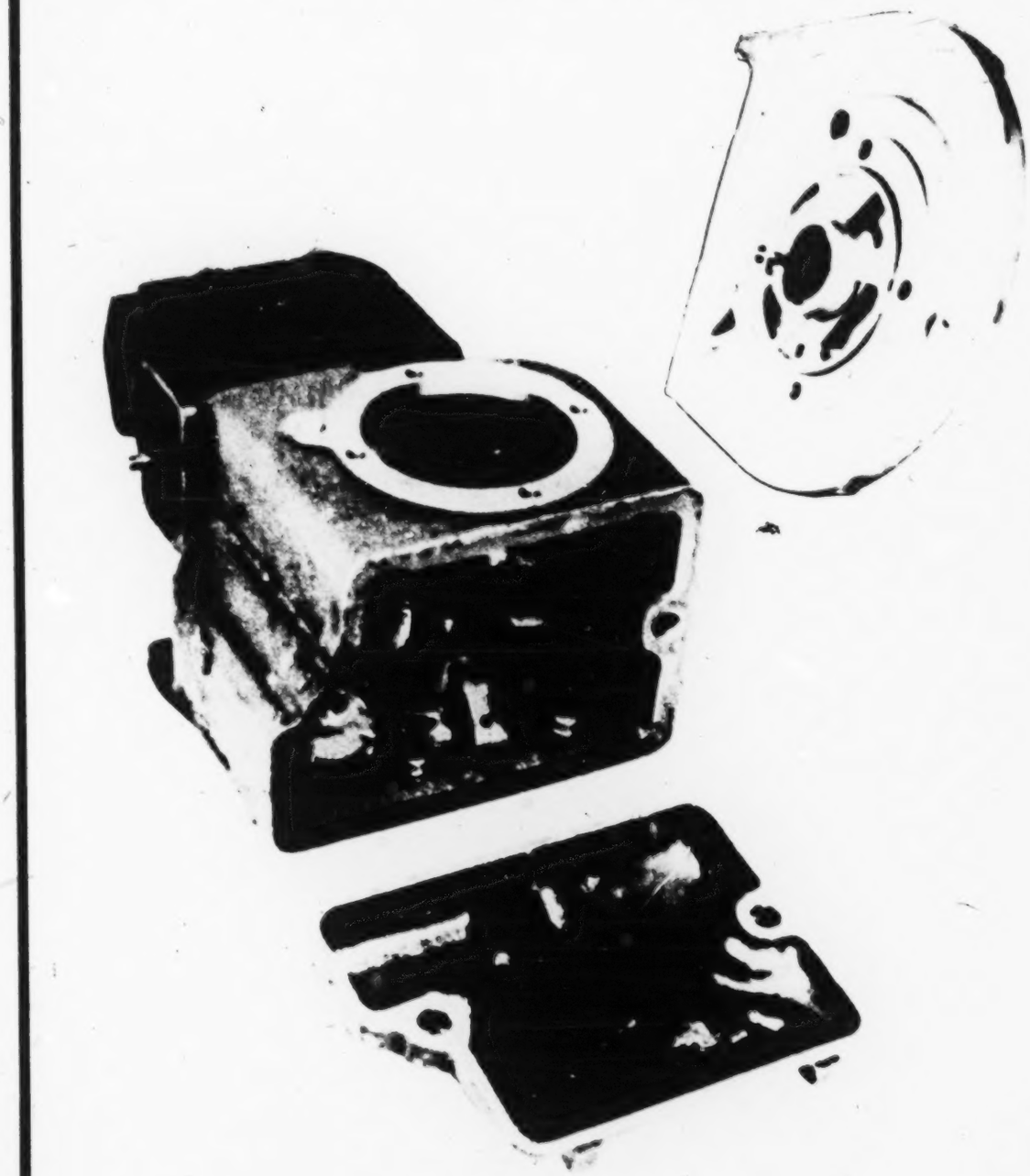
[1]The attainment of a universally adaptable main cylinder-crankcase casting would obviously have been a tremendous forward stride in the art, even if it had not been die castable. However, Lechtenberg's engine body not only has a universally adaptable main part but meets the stringent limitations on form imposed by the requirements of the die casting process—it is die castable. (R 275, 290-291)

BRIGGS & STRATTON MODEL 8 ENGINE, PLAINTIFF'S EXHIBIT 9.



CLINTON VS-700 ENGINE, DEFENDANT'S EXHIBIT D-8.

FIGURE 3

CONVENTIONAL PRIOR ART STRUCTURE OF FOUR-CYCLE ENGINE BODY.

that Lechtenberg had sliced through the hypothetical one-piece engine body it immediately brought out a die cast engine in the form of "a striking and almost slavish copy" of plaintiff's Lechtenberg engine, using photographs of plaintiff's engine parts in its announcements to the trade. Soon after, Lawson Division of Tecumseh Products Co. also went to a close copy of the Lechtenberg engine body in order to enjoy the benefits of die casting.

But the results of Lechtenberg's new "slice" were not limited to making die casting economically feasible. The Lechtenberg "slice" also held significant advantages for a manufacturer who wished to sand cast four-cycle engine bodies:

> Only one pattern would be needed for the main body part, instead of the many different patterns that had always before been needed for sand casting that part. (R 52, 57, 62)
>
> Repair and replacement inventories could be substantially reduced by reason of the universal adaptability of the main body part in the Lechtenberg engine. (R 55-56)
>
> Lechtenberg's "slice" divided the engine body into only two parts (exclusive of the cylinder head[1]), whereas there had always been three or more parts in prior four-cycle engine bodies. Thus assembly was simplified and inventory was further reduced. (RP-527, col. 1, lines 32-41)

A patent claim cannot define an invention so informally as to say that the inventor sliced through a hypothetical one-piece engine body in a new way. Therefore, the

---

[1]The cylinder head always has been made as a separate part on four-cycle engines in order to permit installation of the valves.

claims of the patent in suit define Lechtenberg's new "slice" in terms of what is on each side of it, enumerating the elements of the complete four-cycle engine body that are included in each of the two parts at opposite sides of the "slice".

Thus, quoting from claim 2:

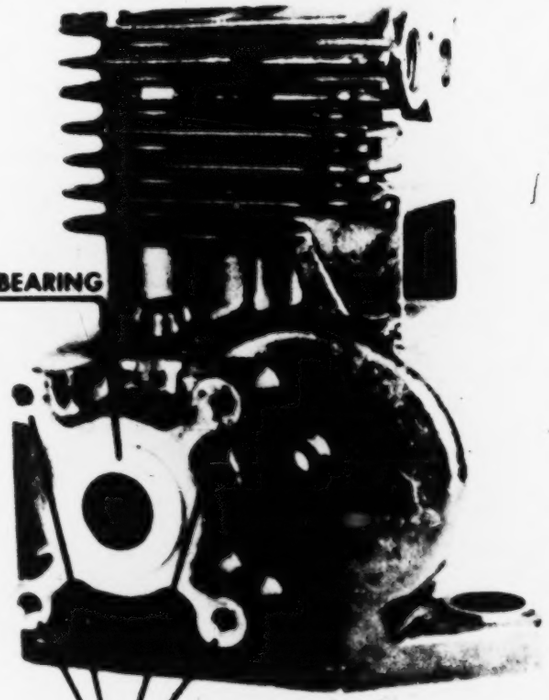
> "The cylinder and all portions of the crankcase including the wall thereof remote from and facing the cylinder, except that wall of the crankcase through which the power takeoff end of the crankshaft passes"

comprises the main body casting, which is one of the two parts of a four-cycle engine body with Lechtenberg's new "slice". What is on the other side of the "slice" is this:

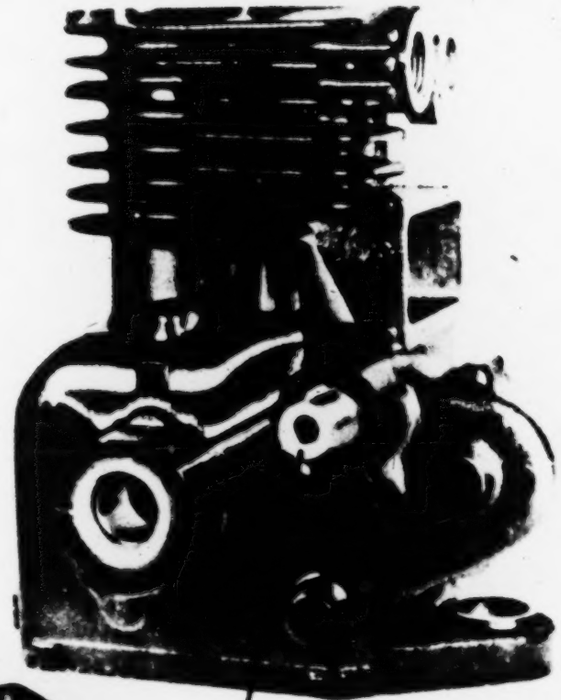
> "said wall through which the power takeoff end of the crankshaft passes is provided by a cover removably secured to" the main body casting.

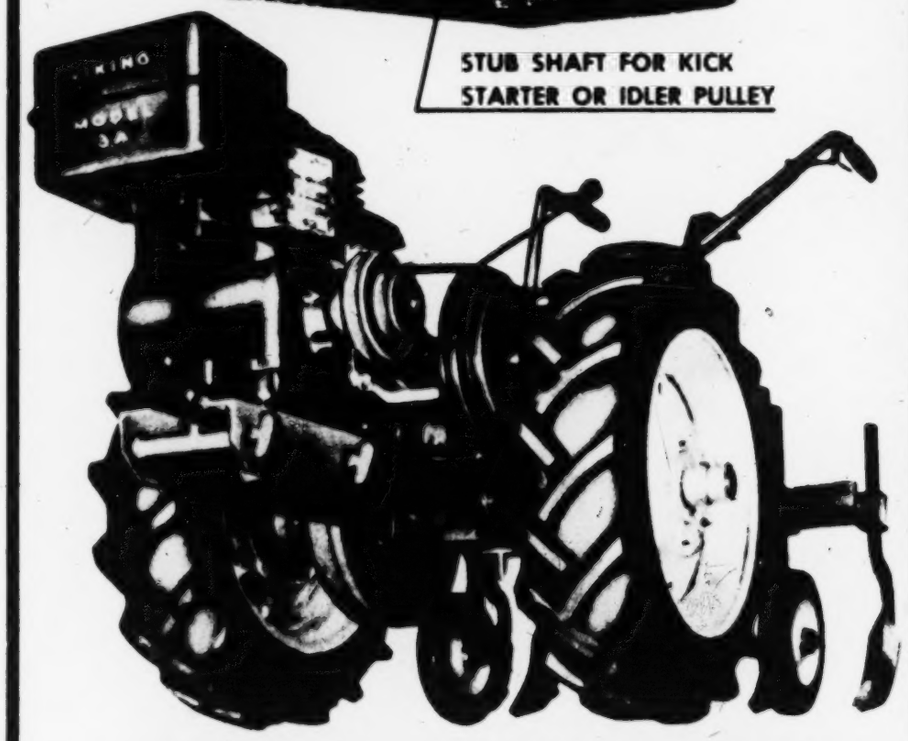
Accordingly, the claims say that Lechtenberg's "slice" is made so that there is a big main cylinder-crankcase casting on one side of the "slice" and a smaller cover on the other side of it, and so that the cover comprises the wall — the entire wall — of the crankcase at that side of the crankcase through which the power takeoff end of the crankshaft passes. The chart facing p. 12 gives a picture of the two parts at the opposite sides of Lechtenberg's "slice" and shows how one of the claims defines these two parts, and also shows how slavishly defendant's accused engine copies the Lechtenberg arrangement.

It is to be observed that the claims are not limited to a die cast engine body. Lechtenberg invented a new structure, characterized by a new arrangement of the body elements of a single cylinder four-cycle engine,

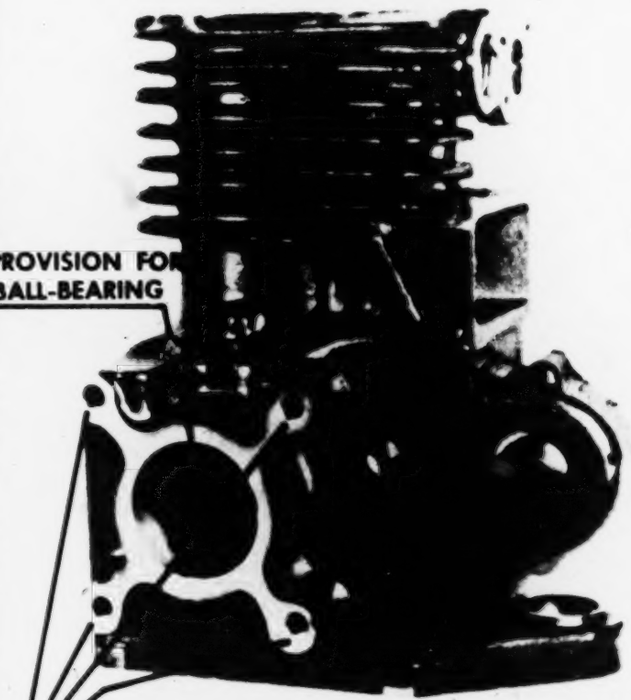


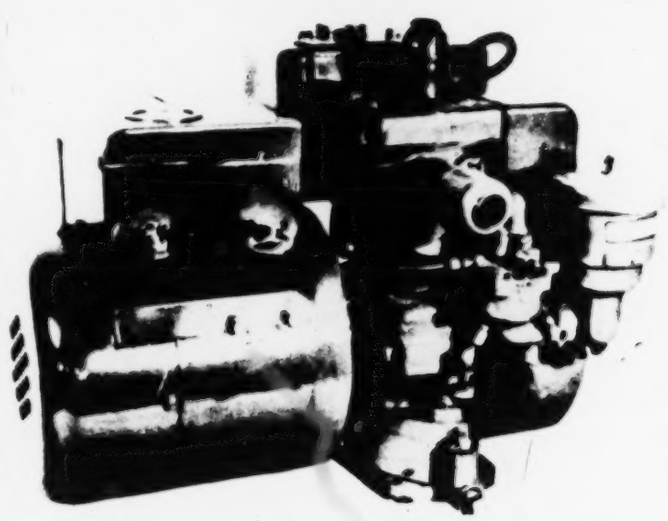
CYLINDER CRANKCASE CASTING OF A BRIGGS & STRATTON VERTICAL SHAFT ENGINE, AND (LOWER) THE ENGINE IN WHICH IT IS INCORPORATED (PLAINTIFF'S EXHIBIT 10).





CYLINDER CRANKCASE CASTING OF STANDARD BRIGGS & STRATTON HORIZONTAL SHAFT ENGINE, AND (LOWER) THE ENGINE (PLAINTIFF'S EXHIBIT 9) EMBODYING THAT CASTING INSTALLED ON A GARDEN TRACTOR.





CYLINDER CRANKCASE CASTING FOR BRIGGS & STRATTON HORIZONTAL SHAFT ENGINE WITH BALL-BEARING CRANKSHAFT BEARING AND ACCESSORY MOUNTING BOSSES, AND (LOWER) THE ENGINE INCORPORATING THAT CASTING WITH A GENERATOR INSTALLED ON IT.

FIGURE 4

ILLUSTRATING "VARIABLES" ON SAND CAST CYLINDER — CRANKCASE MEMBERS OF PRIOR ART ENGINE. THESE DIFFERENCES MADE DIE CASTING OF SUCH AN ENGINE ECONOMICALLY IMPRACTICABLE.

which arrangement provided tremendous advantages in a *sand cast* four-cycle engine body with the new "slice", as well as making it *economically feasible* to die cast the body parts.

Both the District Court and the Court of Appeals expressly found that Lechtenberg had made a forward stride in the art (R 460; Appendix to this petition, pp. 4-5, 8), but they held that he had not made a patentable invention because the Lechtenberg engine contains all of the same o'd elements as the engines of the prior art, functioning in the same way and producing the same results. The concurring opinion of Judge Sanborn (pp. 8-9) is particularly concerned with the inferences that might arise from the novelty of Lechtenberg's new arrangement:

> "As a practical matter, Lechtenberg's contribution to the art * * * was a meritorious one and was both *new* and useful. * * * However, * * * the amount of originality and ingenuity, over and beyond novelty and utility, which will constitute invention necessary to sustain a patent *for a combination of old elements* in a crowded art, has increased." (Emphasis supplied)

REASONS WHY THE WRIT SHOULD BE GRANTED

1. The Courts below have decided an important question of Federal law, relating to the interpretation of 35 U.S.C. § 101, which has not been but should be decided by this Court.

2. The clear cut facts of this case, including the express findings that the claims distinguish from the prior art and that Lechtenberg made a forward stride in the art, provide this Court with an occasion to pass upon the

frequently raised question of whether the Patent Codification Act of 1952, in Sec. 103 thereof, has changed the standard of invention which existed prior to the enactment of that section.

3. The importance of this case to a major American industry makes it imperative that there be an early and definitive pronouncement upon the validity of the Lechtenberg patent.

ARGUMENT

I. The Courts Below Have Decided an Important Question Relating to the Interpretation of 35 U.S.C. § 101 Which Has Not Been But Should Be Decided by This Court.

Ordinarily, an inventor makes a change in the structure of a machine for *functional* reasons — to improve the operation of the machine or to make it do something different from what it has done before. The structural change may entail the addition of a new element to an old combination, as in *Goodyear Tire & Rubber Co. v. Ray-O-Vac Co.*, 321 U.S. 275, 64 S. Ct. 593, or it may involve a change in the organization or arrangement of the elements of a combination, as in *Eibel Process Co. v. Minnesota & Ontario Paper Co.*, 261 U.S. 45, 43 S. Ct. 322. In any event, the inventive change *usually* affects what the device *does*.

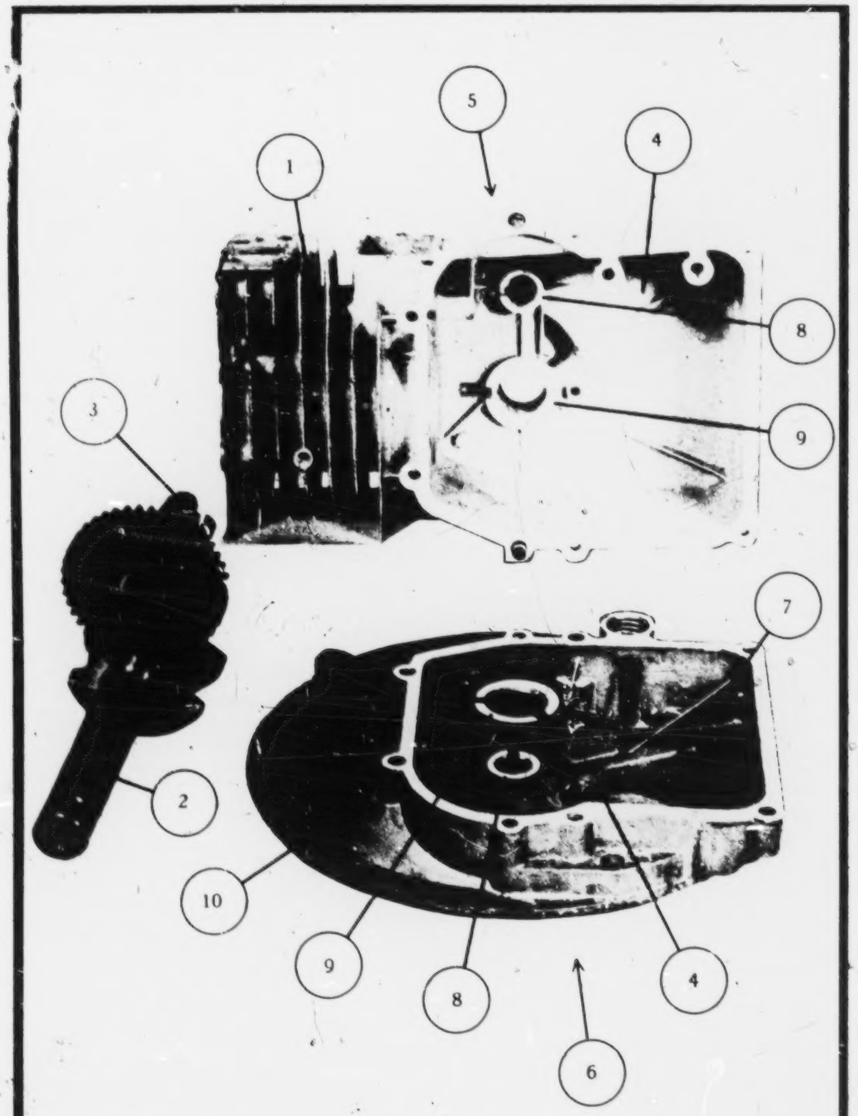
But Lechtenberg's invention is an extraordinary one in that his structural change in the four-cycle engine body was *solely* for the purpose of bringing about *economy in production* of four-cycle engine body parts, without altering the operation or functions of the engine.

Reduction in cost usually results from a method invention, but Lechtenberg did not make a method in-

CHART NO. 1

LECHTENBERG PATENT NO. 2,693,789 INFRINGED BY DEFENDANT'S SERIES VS100 ENGINE

PLAINTIFF'S MODEL 6BH ENGINE



TYPICAL LECHTENBERG CLAIM

Claim 6

A single cylinder, four-stroke cycle internal combustion engine adapted for operation with its cylinder horizontal, said engine having in addition to its

1. cylinder
2. a crankshaft,
3. a cam shaft parallel to the crankshaft, and
4. a crankcase with spaced apart top and bottom walls through which the upper and lower ends of the crankshaft pass,

said engine being characterized by the fact that: the cylinder and all portions of the crankcase except its bottom wall through which the lower end of the crankshaft passes is

5. one casting;

by the fact that said bottom wall comprises

6. a cover removably secured to the casting and having
7. a relatively deep depression;

by the fact that the cam shaft is

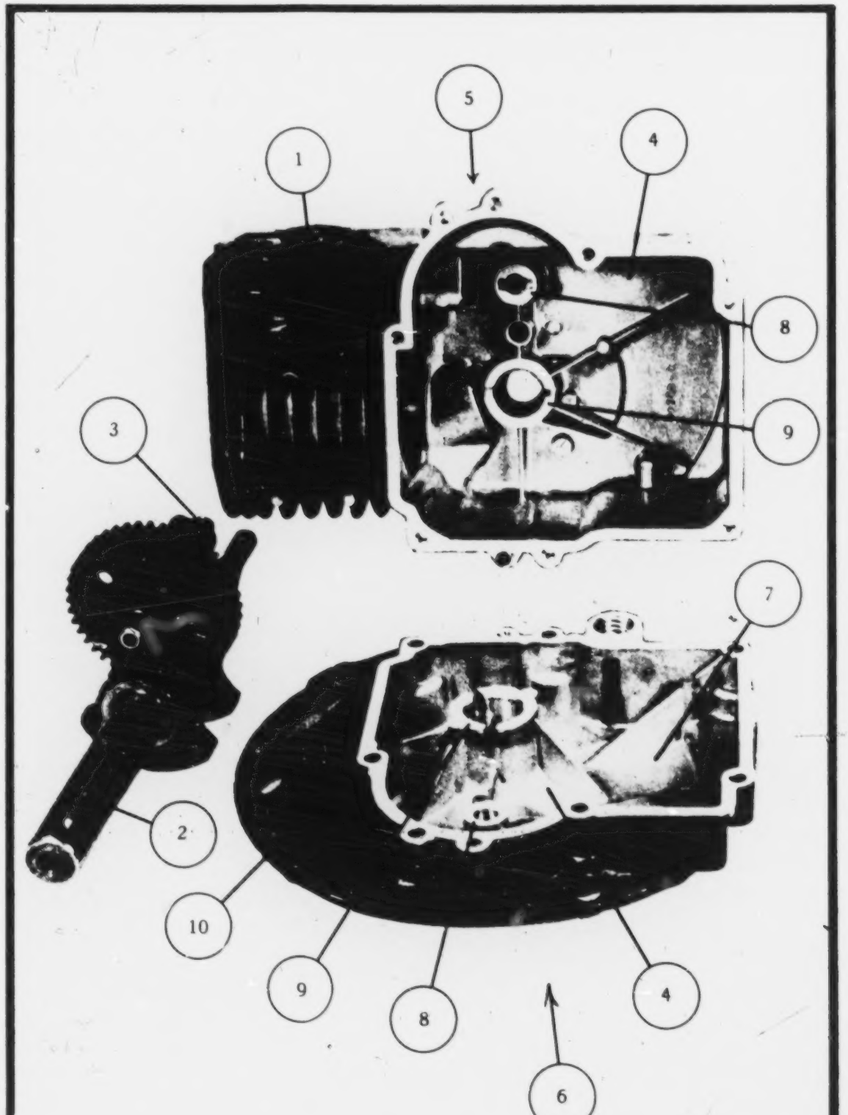
8. supported by the cover and the top wall of the crankcase and the
9. bearings for the crankshaft are in said cover and the top wall of the crankcase;

further by the fact that the depression in the cover provides an oil sump;

and said cover being further characterized by

10. mounting means formed integrally therewith for mounting the engine with its cylinder horizontal.

DEFENDANT'S SERIES VS100 ENGINE



IRA MILTON JONES

vention. His invention makes it feasible to employ a very desirable production method (die casting) that had not previously been available for the manufacture of four-cycle engine body parts, but it also lowers the cost of an engine having body parts produced by the method of sand casting.

The relationship between Lechtenberg's structural change and these results is most easily understood if it is remembered that every "slicing" that had ever been made in the hypothetical one-piece engine body had been made solely and simply for the purpose of achieving *producibility*. Every time a designer designed a four-cycle engine body he selected his theoretical "slices" entirely with an eye to obtaining the greatest *production* advantages — i.e., the lowest cost. Thus, *every* prior art engine body ever built represents an unsuccessful assault upon the problem finally solved by Lechtenberg. Lechtenberg's "slice" is the best that has ever been made because it resulted in the greatest production advantage that had ever been achieved, as shown by the phenomenal 24% reduction in price of the Lechtenberg engine.

This case thus raises the question of whether a structural change such as Lechtenberg made, which brings about no alteration in the function of the changed machine, but which does favorably affect its *producibility*, can constitute patentable improvement under 35 U.S.C. § 101. The holdings of the courts below answer that question in the negative and stand for a rule that patentability must be predicated upon a structural change which affects what the machine does.

The question here under consideration is *not* the usual one of whether a given change is sufficiently unobvious to constitute invention, as "invention" is defined in 35

U.S.C. § 103. The question here is: Is an improvement in producibility the *kind* of invention that is patentable under 35 U.S.C. § 101? Sec. 101 assumes that an invention or discovery has been made, and tells what the invention must *relate to* in order to be patentable. (Conversely, Sec. 103 assumes that an improvement has been made in one of the fields covered by Sec. 101 and tells how *big an advance* it must be to constitute invention.)

Petitioner knows of no case in which the question here in issue has been placed before this Court for determination. It is presented by this case in very clear cut form because all of the Lechtenberg claims are directed to a structural change which the courts below have expressly found to be novel.

The only previous case that comes near to dealing with this question was decided by the Court of Appeals for the Eighth Circuit in a way that is fundamentally in conflict with the instant decision. In *Sbicca-Del Mac v. Milius Shoe Co.*, 145 F. (2d) 389 (1944), two patents were involved, one containing claims to a method and to a shoe produced by that method, and the other containing only method claims. The invention reduced the cost of the shoe but made no functional change in it.

Specifically recognizing the question presented by the instant case, and relating it to the patent statute which was the counterpart of 35 U.S.C. § 101 here involved, the court said in the *Sbicca-Del Mac* case (145 F. (2d) at 393-394):

> "In determining the validity of the patents, therefore, the question presented is whether these advances constitute invention within the meaning of 35 U.S.C.A. § 31. The statute provides that 'Any person who has invented or discovered any new and useful art, machine, manufacture * * * or any new

> and useful improvements thereof * * * not known or used by others * * * may * * * obtain a patent therefor.' We think the * * * patents disclose a new and useful contribution to the art of shoemaking. The patents are not valid, however, unless they reveal invention or discovery."

Thus the court held that the change whereby the cost of the shoe was reduced without altering its function was patentable under the counterpart of 35 U.S.C. § 101, provided the change was an unobvious one. However, the *Shicca-Del Mac* decision turns primarily upon the method aspect of the inventions, rather than upon the change in shoe structure, and it therefore seems to present no clear cut answer to the question raised by the instant case, wherein the structural change made by Lechtenberg reduced the price of an engine regardless of the method used in producing its body parts.

If the *Shicca-Del Mac* case stands for an explicit answer to the question here raised, then its answer is in direct conflict with the decisions in this case by both of the courts below. That the question has been incorrectly answered in this case is suggested by the language of the statute itself, for 35 U.S.C. § 101 says that an invention is patentable if it relates to a "new and useful * * * machine, * * * or any new and useful *improvement* thereof." It is submitted that a change which brings about a reduction in cost (without reduction in quality or other counterbalancing disadvantages) must constitute an "improvement", because a thing is certainly improved when its desirability is increased.[1] This reasoning

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[1]The tremendous commercial success of the Lechtenberg engine shows that the buying public has found increased desirability in it. Plaintiff has built a huge new plant solely for the production of Lechtenberg engines (R 85); defendant admits that its "striking and almost slavish

is consistent with the stand taken by the Eighth Circuit Court of Appeals in the *Sbicca-Del Mac* case.

However, it is apparently not obvious, in view of what the two courts below have held in this case, that a change in an article which brings about a significant price reduction without change in function can be an "improvement" within the meaning of 35 U.S.C. § 101. A definitive pronouncement by this Court is imperative.

II. This Court Should Pass Upon the Question of Whether the Defense of "Aggregation" is Applicable to the Lechtenberg Claims.

The claims of the Lechtenberg patent define a *new arrangement* of the elements comprising a conventional four-cycle engine body, which arrangement brings about greatly improved producibility of the engine body. Heretofore the test of aggregation has always been applied to a finished, assembled device, and such a device has been held to be uninventive if its elements were old and functioned in an old way to produce an old result. But the Lechtenberg invention is not primarily concerned with the engine body in the completely assembled engine, or with the engine as an operating mechanism. It relates to the engine body as *parts in production*. After the body parts have been made, the invention has served its purpose. Lechtenberg's invention is directed entirely to improving the *producibility* of the engine body, and

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copy" of Lechtenberg's engine is its best selling engine (R 45); and since the advent of the Lechtenberg engine the majority of rotary power lawn mowers sold in the United States have been powered by four-cycle engines, whereas previously the less efficient two-cycle engine dominated the power mower field because of its low cost and light weight. (R 54, 263, 266)

therefore the body elements perform in the new arrangement the same functions they have always performed. Under these circumstances, can the claims be tested by the rule that there is no invention in an aggregation of old elements combined in an old way and producing no different function than they have always produced?

The courts below answered this question in the affirmative and held the Lechtenberg patent invalid because they found: "That all the elements were old and that the ten claims constitute an unpatentable aggregation." (Appendix to this petition, p. 7)

The courts below expressly found that Lechtenberg's structural arrangement is novel and they expressly recognized that the result that it brought about was a phenomenal cost reduction. Hence, when they said that what Lechtenberg produced was "an unpatentable aggregation", they were holding that the change he made was not an "improvement" which is patentable under the provisions of Sec. 101.

That the courts below erroneously applied the test of aggregation to the Lechtenberg patent is suggested by *Eibel Process Co. v. Minnesota & Ontario Paper Co.*, 261 U.S. 45, 43 S. Ct. 322. In *Eibel Process* one element of an old paper making machine was given a tilt or inclination, whereas previously it had always been horizontal. No element was added to or removed from the old machine. The result of the rearrangement was a tremendous increase in the productive capacity of the machine, and the patent was held valid even though its claims necessarily recited the old elements of an old machine, each having its old function. Just as with Lechtenberg, the claims in *Eibel Process* defined a *rearrangement* that produced a new result.

In *Eibel Process,* however, the result flowing from the new arrangement was a betterment of the *function* of the machine, and the claims defining the new arrangement were therefore held to be valid. But in this case the new arrangement of engine body parts defined by the claims has nothing to do with the function of the engine but relates only to its *producibility* and *cost,* and this case therefore presents the unresolved question of whether the claims can be held invalid for aggregativeness for that reason.

It remains for this Court to make a definitive pronouncement upon whether the test of "aggregation" has any relevance to the test of patentable subject matter laid down in 35 U.S.C. Sec. 101.

III. This Case Presents a Clear Cut Opportunity for this Court to Make a Definitive Pronouncement upon the Standard of Invention Laid Down in 35 U.S.C. § 103.

The concurring opinion of Judge Sanborn (Appendix to this petition, p. 8) sets forth, in its opening paragraph, that the engine art is a crowded one; and it might have added that the four-cycle engine industry is intensely competitive. Judge Sanborn also expressly recognized that Lechtenberg achieved an engine which weighed about half as much as its predecessor of the same horsepower, and cost about 24% less, and that Lechtenberg's engine was "of course" soon copied by competitors.

While saying that this phenomenal advance "was a meritorious one and was both new and useful", Judge Sanborn concurred in the holding of invalidity with the comment that "the amount of originality and ingenuity, over and beyond novelty and utility which will constitute invention necessary to sustain a patent for a combination of old elements in a crowded art, has increased," citing a number of cases which were decided by this Court before the enactment of the Patent Codification Act of 1952. (P. 9) Thus the Court of Appeals for the Eighth Circuit held that the standard of patentable invention has risen to the point where the sudden attainment of a 24% price reduction and a 50% weight reduction in a crowded art and a highly competitive field must be held to result from nothing beyond mere routine skill.

That holding points to the importance to the American industrial economy of a review by this Court of the present status of the standard of patentability, because the United States patent system provides the incentive for our industrial progress.

Ever since the enactment of the new Patent Codification Act of 1952 this Court has been looked to for a holding on the question of the effect of Sec. 103 of that act upon the "raised" standard of invention referred to in Judge Sanborn's opinion. In effect, Judge Sanborn has said that the new statute did not change the standard of invention, and he has implied that it is, if anything, still rising.

The need for this Court's definitive pronouncement upon the question has been particularly apparent since Judge Hand wrote his well-known decision in *Lyon v. Bausch & Lomb Optical Co.*, 224 F. (2d) 530 (C.A. - 2, 1955, cert. den., 76 S. Ct. 193, 350 U.S. 911), in which he specifically held that in enacting 35 U.S.C. § 103 congress had intended to restore the standard of invention to what it had been in 1850 when this Court decided *Hotchkiss v. Greenwood*, 11 How. 248, 13 L. Ed. 683.

The facts of this case are clear cut, and the question of the applicable standard of invention posed by Judge Sanborn's concurring opinion is distinctly presented in a manner which gives this Court an opportunity to render the definitive pronouncement that has been so long needed.

IV. The Importance of This Case to American Industry Warrants a Definitive Pronouncement by This Court upon the Validity of the Lechtenberg Patent.

It is not too much to say that the Lechtenberg invention has revolutionized the small four-cycle gasoline engine industry.

The tremendous demand for such engines, resulting from the cost reduction achieved by Lechtenberg, has compelled plaintiff to build a huge new plant devoted exclusively to the production of Lechtenberg engines. In this new building, covering about ten acres, hundreds of persons have been given employment by the Lechtenberg invention, turning out hundreds of thousands of such engines every year. (R. 55)

Defendant has admitted that its "striking and almost slavish copy" of the Lechtenberg engine is its best seller. (R 45) In an affidavit filed with the District Court at one point in the proceedings herein, it was stated that defendant employs some 2,000 persons in the production of its accused engine.

A suit is now pending in the United States District Court for the Eastern District of Wisconsin against the Lawson Division of Tecumseh Products Company, charging Lawson with infringement of the Lechtenberg patent. Lawson, too, finds that its copy of the Lechtenberg engine is its best seller.

These manufacturers represent the major portion of the four-cycle engine industry, and together their sales of such engines exceed one hundred million dollars annually. They furnish engines to numerous other manufacturers who build such relatively expensive machines as power lawn mowers, cement and plaster mixers, pow-

er saws, vehicle refrigeration equipment, electric generators, etc. (R 51, 53)

Thus many customers of the small engine industry are following this case closely, realizing that they are prospective infringement suit defendants as well as being interested in the patent system as a whole.

In the power lawn mower field alone, Lechtenberg has wrought a major upset; formerly the majority of rotary mowers were equipped with two-cycle engines, but now most of them are powered by four-cycle engines, all of which, with rare exceptions, have die cast bodies of the Lechtenberg type. (R 54)

It is submitted that the importance of this case, not only to the parties before the Court, but to the American industrial system as a whole, merits this Court's consideration of the unresolved questions of patent law which this case raises.

CONCLUSION

This case presents an important question of first impression concerning the interpretation of 35 U.S.C. § 101, and also presents the question of the status of the "standard of invention" under 35 U.S.C § 103 as to which this Court's definitive pronouncement has been sought since the enactment of the Patent Codification Act of 1952. It is submitted that certiorari should be granted so that this Court may pass upon these important unresolved questions.

Respectfully submitted,

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Counsel for Petitioner

November 29, 1957

APPENDIX TO PETITION FOR CERTIORARI

OPINION OF THE UNITED STATES COURT OF APPEALS FOR THE EIGHTH CIRCUIT

OPINION OF THE

United States Court of Appeals
FOR THE EIGHTH CIRCUIT

No. 15,725

Briggs & Stratton Corporation,
Plaintiff-Appellant,

v.

Clinton Machine Co., Inc.,
Defendant-Appellee.

Appeal from the United States District Court for the Northern District of Iowa.

No. 15,729

Clinton Machine Co., Inc.,
Defendant-Cross Appellant,

v.

Briggs & Stratton Corporation,
Plaintiff-Cross Appellee.

Appeal from the United States District Court for the Northern District of Iowa.

[August 30, 1957.]

Ira Milton Jones and James R. Custin (E. Marshall Thomas was with them on the brief), for Briggs & Stratton Corporation.

E. J. Balluff and Arthur Raisch (Charles R. McKinley, Wayne G. Cook and Hal F. Reynolds were with them on the brief), for Clinton Machine Company.

Before SANBORN, WOODROUGH and JOHNSEN, Circuit Judges.